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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,429

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EXAMINER

HENNING, MATTHEW T

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,429	<b>Applicant(s)</b> LINCOLN ET AL.	
	<b>Examiner</b> MATTHEW T. HENNING	<b>Art Unit</b> 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

1           This action is in response to the communication filed on 7/21/2009.

2                           **DETAILED ACTION**

3                           *Response to Arguments*

4           Applicant's arguments filed 7/21/2009 have been fully considered but they are not  
5     persuasive.

6           Regarding the applicants' argument that Ohashi does not teach that neither obtaining  
7     certificate nor subsequently obtaining permission information uses authentication information  
8     "corresponding to information which is used to authenticate that user's telecommunications  
9     terminal in relation to the telecommunications system", the examiner does not find the argument  
10    persuasive. It appears that the applicants have misinterpreted the rejection. The predetermined  
11    information is the "user certificate" which is stored in the smart card. The certificate is later used  
12    to authenticate the user, and thus the user's client terminal, to the service provider. Further, "a  
13    telecommunications network" is simply a network for the transmission and reception of  
14    information of any type using electrical or optical signals sent over wires or fibers or through the  
15    air. As such, Fig. 1 of Ohashi depicts a telecommunications network to which the user's  
16    telecommunications terminal is authenticated. Therefore, Ohashi does teach this claim  
17    limitation. As such, the examiner does not find the argument persuasive.

18          Regarding the applicants' argument that Ohashi did not teach that "the authentication  
19    process for authenticating the transaction by that user with the data processing apparatus neither  
20    requires that user's telecommunications terminal nor requires the telecommunications terminal to  
21    be actually authenticated by that information in relation to the telecommunications systems", the  
22    examiner does not find the argument persuasive. In rejecting the claims, the examiner has relied

1 upon the client terminal which the client uses to first obtain the certificate as reading on "the  
2 user's telecommunications terminal". Ohashi clearly states that there are numerous client  
3 terminals having similar constitution to this first client terminal, as can be seen in Col. 11 Lines  
4 30-33. Ohashi further teaches that the certificate obtaining step can be ignored when the smart  
5 card already stores a valid certificate, as can be seen in Col. 12 Lines 23-30. As such, Ohashi  
6 clearly teaches that any client terminal may be used in performing the authentication with the  
7 application server. Furthermore, Ohashi does not teach that it is required that the client terminal  
8 is always the user's client terminal, or that it is required that the client terminal be actually  
9 authenticated by the information in relation to the telecommunications systems. Rather it is the  
10 smart card which is authenticated. In this case, because the contested limitation is a negative  
11 limitation, the absence of "requirement" in Ohashi meets the negative limitation. As such, the  
12 examiner does not find the argument persuasive.

13       Regarding the applicants' argument that Ohashi does not teach "each authentication  
14 storage means storing predetermined authentication information and being registerable with a  
15 common telecommunications system for which the users have respective telecommunications  
16 terminals", the examiner does not find the argument persuasive. As discussed above, Ohashi  
17 teaches a plurality of client terminals in the telecommunications system, and that each smart card  
18 stores a certificate which is obtained by request from the telecommunications system. Ohashi  
19 further teaches storing the user's secret keys associated with the smart card inside a database at  
20 the Master AuC, as can be seen in Col. 5 Lines 27-31. This falls within the scope of "being  
21 registerable with a common telecommunications system for which the users have respective  
22 telecommunications terminals". As such, the examiner does not find the argument persuasive.

1 In response to applicant's argument that the references fail to show certain features of  
2 applicant's invention, it is noted that the features upon which applicant relies (i.e., registration of  
3 a SIM card with a cellular telecommunication network; use of a SIM card) are not recited in the  
4 rejected claim(s). Although the claims are interpreted in light of the specification, limitations  
5 from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26  
6 USPQ2d 1057 (Fed. Cir. 1993).

7 Regarding the applicants request for evidence of the official notice taken in the office  
8 action dated January 21, 2009, the examiner provides the following evidence. Regarding the fact  
9 that levying a charge for a transaction (providing network services) was well known in the art at  
10 the time of invention, the examiner points to US Patent 5,978,387, Col. 1 Lines 15-48.  
11 Regarding the fact that smart cards communicating wirelessly with their readers was well known  
12 in the art at the time of invention, the examiner points to US Patent Application Publication  
13 2003/0024994, Paragraph 0028. As such, the examiner does not find the arguments persuasive.

14 All objections and rejections not set forth below have been withdrawn.

15 Claims 1-26 have been examined.

16  
17 ***Claim Rejections - 35 USC § 102***

18 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
19 basis for the rejections under this section made in this Office action:

20 *A person shall be entitled to a patent unless –*

21 *(b) the invention was patented or described in a printed publication in this or a foreign*  
22 *country or in public use or on sale in this country, more than one year prior to the date of*  
23 *application for patent in the United States.*  
24

1           Claims 1-6, 9, 11-16, 20-24, and 26 are rejected under 35 U.S.C. 102(b) as being  
2           anticipated by Ohashi et al. (US Patent Number 5,761,309) hereinafter referred to as Ohashi.

3           Regarding claim 1, Ohashi disclosed a method for carrying out an authentication process  
4           for authenticating a subsequent transaction by any one of a plurality of users with data  
5           processing apparatus (client) (Ohashi Abstract), including the step during the authentication  
6           process of operatively associating with the data processing apparatus a selected one of a plurality  
7           of authentication storage means (smart card) respective to the users, each authentication storage  
8           means storing predetermined authentication information and being registerable with a common  
9           telecommunications system for which the users have respective telecommunications terminals  
10          (Ohashi Col. 12 Lines 19-29), and the step of carrying out the authentication process via a  
11          communications link with the common telecommunications system (Ohashi Col. 12 Lines 30-  
12          36), the authentication process being carried out by authenticating means incorporated in the  
13          telecommunications system and involving the use of the predetermined authentication  
14          information stored by the selected one authentication storage means (Ohashi Col. 12 Lines 30-  
15          36), the predetermined authentication information stored by each authentication storage means  
16          corresponding to information which is used to authenticate that user's telecommunications  
17          terminal in relation to the telecommunications system (Ohashi Col. 12 Lines 30-36) but the  
18          authentication process for authenticating the transaction by that user with the data processing  
19          apparatus not requiring use of that user's telecommunications terminal nor requiring the  
20          telecommunications terminal to be actually authenticated by that information in relation to the  
21          telecommunications systems (Ohashi Col. 5 Paragraph 2).

1           Regarding claim 13, Ohashi disclosed data processing apparatus in combination with a  
2   selected one of a plurality of authentication storage means which are respective to users and are  
3   each for storing predetermined authentication information relating to the carrying out of an  
4   authentication process for authenticating a subsequent transaction by the users with the data  
5   processing apparatus (Ohashi Col. 12 Lines 1-29), the authentication storage means all being  
6   registerable with a common telecommunications system for which the users have respective  
7   telecommunications terminals (Ohashi Col. 12 Lines 19-29), the authentication storage means  
8   when operatively associated with the data processing apparatus being operative to carry out the  
9   authentication process via a communications link with that system (Ohashi Col. 12 Lines 30-36),  
10   the authentication process being carried out by authenticating means incorporated in the system  
11   and involving the use of the predetermined information stored by the selected one authentication  
12   storage means (Ohashi Col. 12 Lines 30-36), the predetermined authentication information  
13   stored by each authentication storage means corresponding to information which is used to  
14   authenticate that user's telecommunications terminal in relation to the telecommunications  
15   system (Ohashi Col. 12 Lines 30-36) but the authentication process for authenticating the  
16   transaction by that user with the data processing apparatus not requiring that use of user's  
17   telecommunications terminal nor requiring the telecommunications terminal to be actually  
18   authenticated by that information in relation to the telecommunications system (Ohashi Col. 5  
19   Paragraph 2).

20           Regarding claim 22, Ohashi disclosed a data carrier (Card Reader) carrying data for use  
21   in and by a data processing apparatus after an authentication process involving the use of the data  
22   processing apparatus and separate authenticating means (Ohashi Col. 12 Lines 1-36), the data

1 carrier also incorporating authentication storage means (Smart Card) storing predetermined  
2 authentication information respective to a user (Ohashi Col. 12 Lines 19-29), the authentication  
3 storage means being registered with a telecommunications system which includes the  
4 authenticating means and for which the user has a telecommunications terminal (Ohashi Col. 12  
5 Lines 19-29), the authentication storage means being responsive to an input message for deriving  
6 a response dependent on the input message and on the authentication information for enabling  
7 the authenticating means to carry out the authentication process via a communication link with  
8 the authenticating means in the said system whereby to authenticate a subsequent transaction by  
9 the user with the data processing apparatus and which involves use of the data carried by the data  
10 carrier (Ohashi Col. 12 Lines 1-36), the predetermined authentication information stored by the  
11 authentication storage means corresponding to information which is used to authenticate the user  
12 registered with the telecommunications system in relation to use of that user's  
13 telecommunications terminal in the telecommunications system (Ohashi Col. 12 Lines 30-36),  
14 but the authentication process for authenticating the transaction by that user with the data  
15 processing apparatus not requiring use of the user's telecommunications terminal nor requiring  
16 the telecommunications terminal to be actually authenticated by that information in relation to  
17 the telecommunications system (Ohashi Col. 5 Paragraph 2).

18       Regarding claim 2, Ohashi disclosed that the authentication storage means is associated  
19 with the data processing apparatus by being associated with data or software for use by that data  
20 processing apparatus (Ohashi Col. 5 Paragraphs 2-3).

21       Regarding claim 3, Ohashi disclosed that the authentication storage means is incorporated  
22 on a data carrier for the data or software (Ohashi Col. 5 Lines 65-67).



Art Unit: 2431

1 *sought to be patented and the prior art are such that the subject matter as a whole would have*  
2 *been obvious at the time the invention was made to a person having ordinary skill in the art to*  
3 *which said subject matter pertains. Patentability shall not be negated by the manner in which*  
4 *the invention was made.*

5 Claims 7-8, 10, 17-19, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over  
6 Ohashi.

7 Regarding claims 7-8, and 17-18, while Ohashi disclosed providing a network service,  
8 Ohashi fails to disclose the system levying a charge for the service transaction. However, it was  
9 well known in the art of service providing to levy charges for providing the service. As such, it  
10 would have been obvious to the ordinary person skilled in the art at the time of invention to have  
11 had the system levy a charge for the service. This would have been obvious because the ordinary  
12 person skilled in the art would have been motivated to provide the service provider with  
13 compensation for the service.

14 Regarding claims 10, 19, and 25, while Ohashi disclosed the smart card communicating  
15 with a smart card reader, Ohashi failed to disclose the communication being wireless. However,  
16 it was well known at the time of invention for smart cards to communicate wirelessly. As such,  
17 it would have been obvious to the ordinary person skilled in the art at the time of invention to  
18 have provided the communications wirelessly. This would have been obvious because the  
19 ordinary person skilled in the art would have been motivated to increase the ease of use for the  
20 user.

## 22 ***Conclusion***

23 Claims 1-26 have been rejected.

1           The prior art made of record and not relied upon is considered pertinent to applicant's  
2 disclosure.

3           **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time  
4 policy as set forth in 37 CFR 1.136(a).

5           A shortened statutory period for reply to this final action is set to expire THREE  
6 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO  
7 MONTHS of the mailing date of this final action and the advisory action is not mailed until after  
8 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period  
9 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37  
10 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,  
11 however, will the statutory period for reply expire later than SIX MONTHS from the mailing  
12 date of this final action.

13           Any inquiry concerning this communication or earlier communications from the  
14 examiner should be directed to MATTHEW T. HENNING whose telephone number is  
15 (571)272-3790. The examiner can normally be reached on M-F 8-4.

16           If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
17 supervisor, William Korzuch can be reached on (571)272-7589. The fax phone number for the  
18 organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2431

1 Information regarding the status of an application may be obtained from the Patent  
2 Application Information Retrieval (PAIR) system. Status information for published applications  
3 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished  
4 applications is available through Private PAIR only. For more information about the PAIR  
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7 like assistance from a USPTO Customer Service Representative or access to the automated  
8 information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9  
10  
11 /Matthew T Henning/  
12 Examiner, Art Unit 2431  
13 /Syed Zia/  
14 Primary Examiner, Art Unit 2431